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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------------|------------------|
| 10/634,176 | 08/04/2003 | Clifford Teoh | 8600-0006.01 00-0207CON | 7120 |
| 20855 | 7590 | 01/25/2005 | EXAMINER | |
| ROBINS & PASTERNAK 1731 EMBARCADERO ROAD SUITE 230 PALO ALTO, CA 94303 | | | HO, UYEN T | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3731 | |

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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|------------------------------|-------------------------------------|-----------------------------|--|
| Office Action Summary | Application No. 10/634,176 | Applicant(s) TEOH ET AL. | |
| | Examiner (Jackie) Tan-Uyen T. Ho | Art Unit 3731 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/5/04 have been fully considered but they are not persuasive. Applicants argue that Ferrera having overlapping loops in its relaxed configuration and Applicants argue that by "non-overlapping" is meant a structure in which the loops formed by the wire making up the device's three-dimensional configuration do not cross back over themselves. By the definition of "non-overlapping" as provided in the specification, with the broadest reasonable interpretation, Ferrera's loops are non-overlapping. Capturing three dimensional device of Ferrera in two dimension shows that the loops formed by the wire do not cross back over themselves or overlap with each other (see the illustration in the advisory action). On page 10 of the Brief on Appeal, Applicants argue that "Ferrera's loops overlap in at least one location, namely the right most loop of the Examiner's depiction, as can be seen by the narrow," Examiner disagrees. The right most loop does not overlap with other loop, the wire is overlap itself to form a loop.

Examiner do not understand how and what path that applicant traced the loops of Ferrera to result in path looking something like Applicant's depiction (see page 10 of the Brief on Appeal or page 5 of Response After Final filed 8/2/04).

Sine the limitation "non-overlapping" is unclear, a new rejection ground is made as follow

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "non-overlapping loops" renders the claim indefinite. The term "non-overlapping loops" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The specification disclose non-overlapping loop being do not overlap itself or with each other. Figure 5, show loops are spaced apart but overlap with each other in three-dimensional configuration when view face-on in three-dimensions. The specification fails to disclose what "non-overlapping loops" is really meant in three-dimensions view.

Examiner made art rejection base on her best understanding of "non-overlapping loops" as follow:

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-8 and 10-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Ferrera et al. (6 638 291). Ferrera et al. disclose a vaso-occlusive device comprising: a linear strand wound into a stable, three-dimensional relaxed configuration comprising a plurality of non-overlapping loops as claimed (see figures 2-3B, loops are non-overlapping in two dimension configuration see the illustration in the office action mailed on 9/8/2004), a deployment tip and a mechanically detachable end adapted to attach and detach from a pusher (Figures 1- 3B), the Ferrera et al.'s vaso-occlusive device being made from the material as claimed (see cols. 6-7) and Ferrera disclose a method as claimed for making the vaso-occlusive device (see figures 13-18 and col. 9, line 64). Note: The introductory statement of intended use and all other functional statements have been carefully considered but are deemed not to impose any structural limitations on the claims distinguishable over the Ferrera et al.'s device which is capable of being used as claimed if one desires to do so.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferrera et al. Although, Ferrera et al. do not disclose additional filamentary material attached to the vaso-occlusive member, it is known in the art that vaso-occlusive member includes additional filamentary material in order to optimize the occlusion. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ additional filamentary material into Ferrera et al.'s vaso-occlusive member in order to optimize the occlusion.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to (Jackie) Tan-Uyen T. Ho whose telephone number is 571-272-4696. The examiner can normally be reached on MULTIFLEX Mon. to Sat..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANHTUAN NGUYEN can be reached on 571-272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



(Jackie) Tan-Uyen T. Ho
Patent Examiner
Art Unit 3731

January 17, 2005